

Part of Case No. 44
Appendix A

GPC1 - P10 - 071

Attorney Docket No. 032283-005

Paper No.

USSN 09/016,869

Filed on behalf of Party Cold Spring Harbor Laboratory

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

(Administrative Patent Judge Sally Gardner-Lane)

COLD SPRING HARBOR LABORATORY,

Junior Party

(Patents 5,962,316 and 5,889,169)

v.

DENNIS A. CARSON and TSUTOMU NOBORI,

Senior Party

(Application 08/227,800)

Patent Interference No. 104,469

COLD SPRING HARBOR REQUEST FOR RECONSIDERATION UNDER §1.658(b)

Interference No. 104,469
Attorney Docket No. 032283-005

BOX INTERFERENCE

Honorable Commissioner of Patents
and Trademarks
Washington D.C. 20231

Sir:

In the Judgment Pursuant to 37 C.F.R. §1.662, dated October 30, 2001, it is stated that Cold Spring Harbor Laboratory "is not entitled to a patent containing claims 1-29 of patent 5,889,169, which correspond to Count 2," and "is not entitled to a patent containing claims 1-40 of patent 5,962,316, which correspond to Count 2." These holdings are in error.

Footnote 1 of the Final Judgment references Paper 69 for "Count 2 and the claims of the parties which correspond to Count 2." In Paper 69, *only* claim 17 of U.S. Patent No. 5,889,169 and *only* claim 14 of U.S. Patent No. 5,962,316 were designated as corresponding to the Count. *See*, Section 3, page 3, of Paper 69. Claims 1-16 and 18-29 of U.S. Patent No. 5,889,169 and claims 1-13 and 15-40 of U.S. Patent No. 5,962,316 were designated as *not* corresponding to the Count. *See*, Section 4, page 3, of Paper 69. The same designations were made for Count 1 in the initial Declaration of Interference. *See*, page 49 of Paper 1.

Interference No. 104,469
Attorney Docket No. 032283-005

Cold Spring Harbor Laboratory is thus entitled to a patent containing Claims 1-16 and 18-29 of U.S. Patent No. 5,889,169 and claims 1-13 and 15-40 of U.S. Patent No. 5,962,316. A corrected Judgment Pursuant to 37 C.F.R. §1.662 stating that Cold Spring Harbor Laboratory is not entitled to only claim 17 of U.S. Patent No. 5,889,169 and only claim 14 of U.S. Patent No. 5,962,316 is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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Date: October 30, 2001

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the attached COLD SPRING REQUEST FOR RECONSIDERATION UNDER §1.658(b) was served by pre-paid overnight courier on October 30, 2001, on the attorney of record for Senior Party Carson, Edward J. Keeling, Esq., TOWNSEND and TOWNSEND and CREW LLP, Two Embarcadero Center, 8th Floor, San Francisco, CA 94111-3834 and non-party Kamb, Bart G. Newland, Esq. ROTHWELL, FIGG, ERNST & KURZ, 555 Thirteenth Street, N.W., Suite 701, East Tower, Washington, D.C. 20004.

October 30, 2001

Kathryn Ohrubia
Kathryn Ohrubia

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 82

Filed by: Trial Section Merits Panel
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UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

COLD SPRING HARBOR LABORATORY
Junior Party,
(Patents 5,962,316 and 5,889,169)

v.

DENNIS A. CARSON and TSUTOMU NOBORI
Senior Party,
(08/227,800)

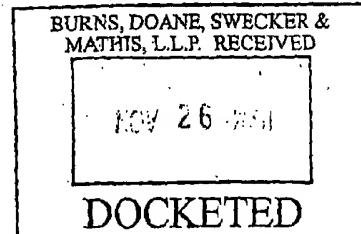
Patent Interference No. 104,469

Before LEE, SPIEGEL, and GARDNER-LANE, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

ORDER ON REQUEST FOR RECONSIDERATION AND JUDGMENT UNDER §1.662

Junior party Cold Spring Harbor Laboratory has filed a paper entitled "COLD SPRING HARBOR LABORATORY REQUEST FOR RECONSIDERATION UNDER §1.658(b)" (Paper 81). In the paper Cold Spring Harbor requests reconsideration of a judgment pursuant to 37 CFR § 1.662 entered 30 October 2001 (Paper 80). The Cold Spring Harbor request is GRANTED.



In the judgment, it is stated that "junior party COLD SPRING HARBOR LABORATORY, is not entitled to a patent containing claims 1-29 of patent 5,889,169, which correspond to Count 2" and that "junior party COLD SPRING HARBOR LABORATORY, is not entitled to a patent containing claims 1-40 of patent 5,962,316, which correspond to Count 2."

In the request for reconsideration, Cold Spring Harbor Laboratory correctly points out that only claim 17 of patent 5,889,169 and only claim 14 of patent 5,962,316 were designated as corresponding to Count 2, the sole count in the interference (See Paper 69 at 3).

Accordingly, the judgment entered 30 October 2001 (Paper 80) is in error.

ORDER

Upon consideration of the record of the interference, it is ORDERED that the request for reconsideration under 37 CFR § 1.658(b) filed by junior party COLD SPRING HARBOR LABORATORY is GRANTED;

FURTHER ORDERED that the judgment pursuant to 37 CFR § 1.662 entered 30 October 2001 (Paper 80), is VACATED;

FURTHER ORDERED that judgment on priority as to Count¹,

¹ Count 2 and the claims of the parties which correspond to Count 2 are set forth at Paper 69 (Order Redeclaring Interference).

the sole count in the interference, is awarded against junior party COLD SPRING HARBOR LABORATORY²;

FURTHER ORDERED that junior party COLD SPRING HARBOR LABORATORY, is not entitled to a patent containing claim 17 of patent 5,889,169, which corresponds to Count 2;

FURTHER ORDERED that junior party COLD SPRING HARBOR LABORATORY, is not entitled to a patent containing claim 14 of patent 5,962,316, which corresponds to Count 2;

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative records of COLD SPRING HARBOR LABORATORY'S 5,889,169 and 5,962,316 patents and CARSON'S 08/227,800 application; and

FURTHER ORDERED that, if there is a settlement agreement, the parties are directed to 35 USC § 135(c).

Jameson Lee
JAMESON LEE
Administrative Patent Judge

Carol A. Spiegel
CAROL A. SPIEGEL
Administrative Patent Judge

Sally Gardner-Lane
SALLY GARDNER-LANE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

² The named inventors of the Cold Spring Harbor Laboratory involved in the interference are set forth at pages 45 and 46 of Paper 1 (Notice Declaring Interference).

cc (via facsimile and first class mail):

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